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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LE, MICHAEL	
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DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,517	<b>Applicant(s)</b> MACHIDA ET AL.	
	<b>Examiner</b> Michael Le	<b>Art Unit</b> 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Action Summary***

1. Claims 1-12 are pending.
2. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 101.
3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph.
4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (US Patent Pub 2002/0087706) in view of Skillen et al. (US Patent 6,098,065), further in view of Suzuki et al. (US Patent 5,675,738).

### ***Priority***

5. Applicant's claim to foreign priority under 35 U.S.C. 119(a)-(d) or 365(b) to Japanese Application No. P2002-198948 and Japanese Application No. P2002-198988, both filed July 8, 2002, is acknowledged. Receipt of the certified priority documents is acknowledged. Applicant is requested to amend the Specification by inserting the claim to foreign priority as the first paragraph after the title. Consequently, claims 1-12 have been examined with a priority date of July 8, 2002.

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "110" has been used to designate both in figure 1, the search engine and figure 15, the user management part. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The abstract of the disclosure is objected to because it exceeds the maximum length and it seems to have run-on sentences, which make the abstract difficult to follow. Correction is required. See MPEP § 608.01(b).

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and Method for Searching and Retrieving Information Regarded Related Goods and Services

10. The disclosure is objected to because of minor informalities. Some examples are:

11. On page 2, line 12, --the-- has to be inserted after "through".

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12. On page 2, line 19, “a” has to be deleted before “travel”.
13. On page 33, line 17 and 23, the word “supposed” has to be deleted.
14. On page 36, line 1 –the-- has to be inserted before “need”.
15. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. **Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. **Claims 1, 4, 7 and 10** recite “letting” in claim 1, line 13; claim 4, line 13; claim 7, line 21; and claim 10, line 23. The term “letting” used in the claim language is indefinite because it is unclear whether the action is being performed or not. Merely “letting” a function be performed does not necessarily mean that it is performed. The Examiner interprets the limitations without the term “letting”.

19. **Claims 1 and 4** recite “is allowed to” in claim 1, line 35 and claim 4, line 36. The phrase “is allowed to” is indefinite because it is interpreted to be “can” or “capable”. Merely stating that the ticket “is allowed to” contain information, does not necessarily mean that it does. The Examiner interprets the limitation to mean that the ticket contains the information.

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20. **Claims 1, 4, 7 and 10** recite presenting to the user “the information about the commodity included in the ticket” and “the information about the service” in claim 1, lines 31-32; claim 4, lines 32-33; claim 7, lines 38-39; and claim 10, lines 39-40. According to a limitation recited in each of the claims, both types of information are not required. In claim 1, lines 9-11 recite “both or one of information about the commodity and information about the service related to the commodity”. Claims 4, 7 and 10 recite similar language. The limitation only requires one type of information, as a result, there is a contradiction. The Examiner interprets the limitation to only require one type of information to be presented to the user.

21. **Claims 8 and 9** recite language that is unclear. Claim 8 begins to recite a limitation regarding registration of user information wherein the users are the requestors, however the remaining claims seem to be directed towards service providers registering tickets wherein the service providers are the registered users from the first limitation. The Examiner interprets the user in claim 8 to be the service provider. Claim 9 recites “user information of the user from the registered user” in lines 11-12. The multiple recitations of “user” make the language unclear. The Examiner suggests revising the language to be more clear and concise.

22. **Claims 4-6 and 10-12** fail to recite active method steps. The method claims fail to recite positive steps delimiting how the use is actually practiced. See MPEP 2173.05(q).

23. **Claims 2 and 3** are rejected because they depend on a rejected claim. Dependent claims contain the limitations of the parent claims and are therefore rejected for the same reasons.

24. The prior art rejections below for claims 1-12 are made as best understood in light of the 35 U.S.C. 112, second paragraph rejections addressed above.

***Claim Rejections - 35 USC § 101***

25. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 1-3 and 7-9 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the present case, **claims 1-3 and 7-9** recite a system with components that are claimed using the means plus function. A review of the Specification to determine each of the means failed to result in any discernable physical components. The Examiner reasonably interprets that the components of the system of claims 1-3 and 7-9 are merely software components. For a system claim to be statutory, it must have physical components, which define the system's physical structure. A system that does not have physical structure can not be categorized in any of the statutory categories of invention and is therefore nonstatutory.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. **Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (US Patent Pub 2002/0087706), in view of Skillen et al. (US Patent 6,098,065) hereinafter “Skillen”, further in view of Suzuki et al. (US Patent 5,675,738), hereinafter “Suzuki”.**

28. In regards to **claim 1**, Ogawa discloses a service and information provision system comprising:

- a. ticket storage-management means for storing and managing a ticket (Ogawa: Fig. 2, element 317) containing an identifier given to a commodity (Ogawa: Fig. 5, element “mailname”), an access address of a service provider for providing a service related to the commodity (Ogawa: Fig. 5, element “URL”) and information about the commodity (Ogawa: Fig. 5, element “Comment”);
- b. search control means for, based on an identifier and a ticket request submitted by a user, the ticket storage-management means execute a search for ticket corresponding to the identifier (Ogawa: para. 0143, 0144)<sup>1</sup>;
- c. service information acquiring means for retrieving an access address of a service provider included in the ticket obtained by the search (Ogawa: para. 0143, 0144, 0145),

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<sup>1</sup> The service provider apparatus (search control means) receives the email from the user (ticket request) and extracts the relevant information and identifies the user’s identification ID (an identifier) and then accordingly extracts comments corresponding to the requested goods and services.



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demanding service provision content information from the service provider on the basis of the access address of the service provider (Ogawa: para. 0148), and acquiring the service provision content information (Ogawa: para. 0150);

d. presentation control means for presenting to the user the information about the commodity included in the ticket and the service provision content information acquired (Ogawa: para. 0150);

29. Ogawa does not expressly disclose:

a. wherein the ticket contains information for deriving an identifier different from the aforementioned identifier, as the information about the commodity or as the information about the service; and

b. wherein the search control means commands the ticket storage-management means to further execute derivation of a different identifier based on information acquired from the ticket obtained by the search, and a search for a ticket corresponding to the different identifier.

30. Skillen discloses an associative search engine, which receives a search request from a user that includes a search argument (identifier). The associative search engine then searches for all products (services) matching the search argument (identifier) as well as other related products that may be relevant to the user based on the search argument. The results are then displayed to the user. (Skillen: col. 4, lines 29-45). Skillen further discloses user profile data being stored in the user device and having it accessible by the associative search engine, thereby using the user profile data to augment the original search arguments to find the best fitting data for the user (Skillen: col. 5, lines 7-17, 61-63; col. 6, lines 4-12, 38-43). Skillen also discloses the search

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engine contains algorithms and techniques to derive search arguments during a single session with the product database (Skillen: col. 5, lines 29-34).

31. Ogawa and Skillen are analogous art because they are both from the same field of endeavor of information retrieval.

32. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the system of Ogawa by adding to the ticket information for deriving an identifier different from the aforementioned identifier, as the information about the commodity or as the information about the service and modifying the search control means to command the ticket storage-management means to further execute derivation of a different identifier based on information acquired from the ticket obtained by the search, and a search for a ticket corresponding to the different identifier, as taught by Skillen.

33. The motivation for doing so would have been because it is desirable for users to retrieve relevant information when searching for data, including associated information (Skillen: col. 1, lines 38-49).

34. Ogawa and Skillen do not expressly disclose:

- a. a procedure file storing access method information for connection to a service;
- b. further including in the ticket, storage location information of the procedure file;
- c. access method information retrieving means for retrieving storage location information of a procedure file included in the ticket;
- d. accessing the service based on the access methods stored in the procedure file;
- e. presenting the retrieved access method information to the user;

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35. Suzuki discloses a connection file (procedure file) for storing connection data (access method information) for connecting through a control mechanism to a server that stores the requested information (accessing the service based on the access methods in the procedure file) (Suzuki: col. 5, lines 14-20). Suzuki also discloses searching the connection file, therefore the storage location is known (Suzuki: col. 10, lines 36-37). Suzuki further discloses sending a response to the request terminal once a connection has been established (present retrieved access method information to the user) (Suzuki: col. 10, lines 48-49).

36. Ogawa, Skillen and Suzuki are analogous art because they are from the same field of endeavor of information retrieval.

37. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the combined system of Ogawa and Skillen by adding a procedure file storing access method information for connection to a service, further including in the ticket, storage location information of the procedure file, access method information retrieving means for retrieving storage location information of a procedure file included in the ticket, accessing the service based on the access methods stored in the procedure file and presenting the retrieved access method information to the user, as taught by Suzuki.

38. The motivation for doing so would have been because when a user requests data from a server, it may be possible that the type of connection for accessing data on one server may be different from another server. A connection file that contained information on how to connect to each type of server would be advantageous because it would allow connection from a single request terminal using the appropriate connection file instead of multiple request terminals connecting to corresponding servers (Suzuki: col. 1, lines 17-67; col. 2, lines 1-8).

39. In regards to **claim 2**, the limitation was addressed in the rejection to claim 1 above as being disclosed by Skillen. Skillen discloses:

- a. a request accepting means for accepting an identifier and a ticket request submitted by a user, with identification of the user (Skillen: col. 5, lines 61-63; col. 6, lines 4-12); and
- b. user information memory means for memorizing use information containing user's preference information and service use information, in correlation with identification information of a user (Skillen: col. 5, lines 7-17),
- c. wherein the presentation control means retrieves from the user information memory means, user information correlated with identification information of a user acquired in acceptance by the request accepting means, selects a service provider on the basis of the user information and the service provision content information, and presents to the user, service provision content information and access method information about the service provider thus selected (Skillen: col. 6, lines 1-19, 38-43).

40. In regards to **claim 3**, Ogawa discloses wherein the presentation control means performs a search with a search engine, using a keyword included in the information about the commodity or in the information about the service, as a search key, and presents to the user, link information obtained by the search (Ogawa: para. 0142-1045)<sup>2</sup>.

41. **Claims 4-6** are substantially similar to claims 1-3 in the form of a method and are rejected for the same reasons.

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42. **Claim 7** is the substantially similar as claims 1 and 2 combined with additional limitations. In regards to the additional limitations, Ogawa discloses wherein the ticket contains permission condition information indicating a condition for a user to whom presentation of the information included in the ticket is permitted (Ogawa: para. 0146)<sup>3</sup>, and wherein the presentation control means is configured to retrieve from the user information memory means, user information correlated with identification information of the user acquired in the acceptance, to determine whether the presentation of the information in the ticket to the user is to be permitted, based on the user information and the permission condition information in the ticket, and to perform the presentation to the user when the presentation is permitted (Ogawa: para. 0149-0150, 0153-0154).

43. In regards to **claim 8**, Ogawa discloses:

- a. user registration means for keeping and managing predetermined registration information of users belonging to a community and, in response to a registration request from a user, registering registration information of the user (Ogawa: para. 0175-0177); and
- b. ticket registration requesting means for accepting a registration request for registration of a ticket containing an identifier given to a commodity related to user information of the user and an access address of the user, which is submitted from the registered user becoming the service provider and desiring to provide information of the

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<sup>2</sup> The mail server searches the content database using the relevant information desired by the user (information about the service as a search key) and then forms a return mail to be sent back to the user containing the URLs of the homepage (presents to the user link obtained by the search).

<sup>3</sup> A required password is interpreted as a permission condition.

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access address of the user, and requesting the ticket storage-management means to register the ticket (Ogawa: para. 0176-0181),

c. wherein the ticket storage-management means registers a new ticket containing the identifier and the access address, based on the registration request for registration of the ticket (Ogawa: para. 0179)<sup>4</sup>.

44. In regards to **claim 9**, Ogawa discloses:

a. user registration means for keeping and managing predetermined registration information of users belonging to a community and, in response to a registration request from a user, registering registration information of the user (Ogawa: para. 0175-0177); and

b. user information managing means for accepting an information presentation request for presentation of information of a ticket about a commodity related to the user information of the user from the registered user, and updating the user information of the user memorized in the user information memory means, to correlate the user information of the user with the permission condition information about the ticket so as to permit the presentation of the information in the ticket to the user (Ogawa: para. 0136-0137, 0146, 0149-0150, 0154).

45. **Claims 10-12** are substantially similar to claims 7-9 in the form of a method and are rejected for the same reasons.

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<sup>4</sup> The service provider apparatus is interpreted as the ticket storage-management means.

***Conclusion***

46. The following are prior art made of record and not relied upon but is considered pertinent to applicant's disclosure.

47. Chanos (US Patent Pub 2002/0032597) discloses a system and method for providing request based consumer information. Greco et al. (US Patent Pub 2002/0120680) discloses a system and method for providing electronic document services. Matsuo (US Patent Pub 2003/0074398) discloses an information providing system and method. Corey et al. (US Patent 5,987,446) discloses a method of searching large collections of text using multiple search engines concurrently. Kraft et al. (US Patent 6,529,899) discloses a system and method for registering and providing a tool service. Robertson (US Patent 6,609,106) discloses a system and method for providing electronic multi-merchant gift registry services over a network. Netvision (International Publication WO 00/25241) discloses a method for supplying services via at least one network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Michael Le  
Art Unit 2163  
January 20, 2006



**UYEN LE**  
**PRIMARY EXAMINER**